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JUDITH A. SZEPESSI, BLAKELY SOKILOFF TAYLOR & ZAFMAN LLP. 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 02/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

JB

Office Action Summary	Application No.	Applicant(s)
	09/814,159	RODRIGUEZ ET AL.
	Examiner	Art Unit
	James H Zurita	3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 8 November 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-50 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 44-50 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. _____
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____ 5) Notice of Informal Patent Application (PTO-152)
 _____ 6) Other: _____

Art Unit: 3625

DETAILED ACTION

Election/Restriction

Applicant confirms constructive election with traverse. The traversal is on the ground(s) that the claims are directed to a media gateway receiving a particular asset of interest and are directed to an invention that is not distinct.

This is not found persuasive for reasons explained in previous office action.

The requirement is still deemed proper and is therefore made FINAL.

Response to Amendment

In an amendment filed 8 November 2004, Applicant amended claims 1, 22.

Claims 1-50 are pending, of which claims 44-50 are withdrawn from consideration.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6-25, 27-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., (US 5,892,900).

Ginter discloses methods and systems to track transactions involving media assets over a data network that is serviced by one or more Rights Distributor 106, Fig. 2 (applicant's service providers).

As per claims 1 and 22, Ginter discloses executable code for

(a) ***tracking information*** characterizing a particular media asset of interest that is sent to the data network. See, for example, at least Col. 56, lines 1-55. For tracking data concerning an media assets, please see at least references to audits and audit trails, at least Col. 155, line 3-36. See also at least references to logs, event log **442**, for example, Col. 161, lines 36-51. See also at least references to chain of handling and control, Col. 6, lines 14-26.

Ginter discloses device(s), i.e., gateways, that receive plurality of media assets uploaded from a plurality of devices. See, for example at least Fig. 1, which discloses multiple networks connected to Ginter's information utility network. These networks are often connected by gateway device(s) so that information can be passed from one to the other (uploaded and downloaded). Such information includes a plurality of media assets. Several examples include a video production studio (204) connected to 200. See also office 210, which shows a plurality of devices (one per window) connected to a network that connects to 200. Each entity in Fig. 1 may connect to 200 via gateway

(b) ***receiving and processing a request*** to engage one or more of said service providers to perform one or more services for the particular media asset. See, for example, Col. 77, lines 15-41. See also at least references to end-users customers, Fig. 18 and related text, at least Col. 137, lines 21-50. For other examples of customers using particular media assets, please see at least Col. 278, line 40-Col. 279, line 32. See also at least references to users **11**, in Figs. 2 and 77 and related text.

(c) ***tracking transaction information*** allowing billing of requested services. See at least Col. 24, lines 24-48, for references to meters to record usage that is later billed.

(d) ***tracking transaction information*** that may include information indicating which service providers performed a service for the particular media asset. See, for example, at least references to rights distributor identification, partnerships, providing payments to rights distributor. For billing, see at least Col. 10, line 15-Col. 11, line 21.

Ginter **does not** always use the term ***module*** when referring to executable code.

Ginter **does not** specifically refer to

[a first unlabelled] module for receiving uploading...as in claim 22
[third through n-th unlabelled] modules for tracking... as in claim 22
[a second unlabelled] module for processing a request, as in claims 22 and 37
report generation module, as in Claims 33, 34, 35, 37, 42
sharing module, as in claim 36

Ginter's terminology includes *load module, objects, methods, containers, smart containers*, etc. These and other units of executable code perform functions claimed by applicant as being performed by *modules* with various labels.

However, the specific label attached to one or more modules loaded onto a processor does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of label to various modules in the system taught by Ginter because the subjective interpretation of the labels connected to various modules does not patentably distinguish the claimed invention.

Ginter **does not** use the term ***service provider*** to refer to entities that manage the gateway, network and stored media assets. Ginter refers to these entities by various other terms, including rights distributors, sub-distributors, re-distributors,

partners. See, for example, at least Col. 294, lines 17-52. These entities receive requests from customers to perform services for particular media assets.

Again, the specific meaning/interpretation of the actions of the one or more entities does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to refer to entities doing business across a network by various names in the system taught by Ginter because the subjective interpretation of the labels connected to various entities does not patentably distinguish the claimed invention.

Ginter **does not** use the term *upload*. To upload is to transmit data from a computer to a network.¹ It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and knowledge generally available to one of ordinary skill in the art to disclose uploading data, including particular media asset of interest to a network. To enable information to be passed from one network to another, the data is received by gateways, i.e., device(s) that connect networks.

One of ordinary skill in the art at the time the invention was made to would have been motivated to combine Ginter and knowledge generally available to one of ordinary skill in the art to disclose uploading data, including particular media asset of interest to a network for the obvious reason by transmitting data from a user's computer to a network provides an easy, efficient way to made the data available to others who use the network.

¹ Definition of *upload*, RANDOM HOUSE WEBSTER'S Computer and Internet Dictionary.

Ginter does **not use** the term “media gateway” To enable information to be passed from one network to another, the data is received by gateways, i.e., device(s) that connect networks. However, the labels given to various actors and modules are not functionally related to the substrate of the article of manufacture. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and knowledge generally available to one of ordinary skill in the art to disclose a “media gateway” that receives plurality of media assets uploaded from a plurality of devices and to apply a label to various actors and modules in a system such as Ginter because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

As per claims 2 and 23, Ginter discloses that media assets may include selected ones of digital images, audio, video, and text-based media. See, for example, at least Col. 23, lines 1-35.

As per claims 3 and 24, Ginter **does not** use the term **wireless carrier**. Ginter discloses that service providers include a wireless communication, including cellular devices. See, for example, at least Fig. 7, related text and Col. 60, line 56-Col. 62, line 35. The Examiner takes official notice that cellular devices often use wireless carriers to communicate.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter with general knowledge to disclose the use of wireless carriers for wireless communication. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter with general knowledge to disclose the use of wireless carriers for wireless communication for the obvious reason that wireless communications often take place at least in part via wireless carriers, including wireless data networks and wireless telephone systems.

As per claims 4 and 25, Ginter discloses that service providers may include online e-commerce partner(s) that provide services in conjunction with processing various media asset. See, for example references to business partnerships, agreements, at least Col. 21, line 38-Col. 22, line 36, Col. 31, lines 27-53.

As per claims 6 and 27, Ginter discloses that data network may include connectivity to the Internet. See, for example, at least Col. 18, line 39-Col. 19, line 27, Col. 24, line 49-Col. 25, line 35.

As per claims 7 and 28, Ginter **does not** use the term *Internet Service Provider*. An Internet Service Provider (ISP) is a company that provides access to the Internet.² Ginter discloses that users and customers may access networks and gateways via the Internet. See, for example, at least Col. 18, line 39-Col. 19, line 27, Col. 24, line 49-Col. 25, line 35. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and knowledge generally available to disclose the use of Internet Service Providers. One of

² Definition of *Internet Service Provider*, Id.

ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and knowledge generally available to disclose the use of Internet Service Providers for the obvious reason that ISPs provide a convenient way to access the Internet and browse the World Wide Web, for example. Users may participate in electronic commerce, by offering and accepting and buying and selling items, including media assets described by Ginter. This may provide stimulus to our economy and may generate increased revenue to merchants.

As per claims 8 and 29, Ginter discloses that

(a) a request may comprise an e-commerce transaction that requires services provided by multiple service providers. See, for example, at least references to multiple parties, Col. 91 lines 26-67. See also at least references to chains of distributors, Col. 6, lines 15-28. For example, see also at least references to value chain business models, Col. 10, line 32-65.

(b) transaction information may allow billing of requested services for revenue sharing among multiple service providers for servicing an e-commerce transaction. See, for example, references to financial partnerships, at least Col. 312, line 45-Col. 313, line 8.

As per claims 9 and 30, Ginter discloses tracking expense sharing among multiple service providers for servicing the e-commerce transactions. See at least Col. 263, lines 43-62. See also references to lowering costs of distributing content, lowering usage costs, decreased transactions costs Col. 30, line 40-Col. 31, line 5, Col. 230, line 44-55.

As per claims 10-13 and 41-42, concerning Reports and Billing Ginter

discloses various types of reports, including reports concerning billing information. See, for example, at least Col. 14, lines 25-48, Col. 35, line 59-Col. 36, line 40, Col. 43, lines 43-56, Col. 45 lines 30-48, Col. 56 lines 30-46, Col. 58 line 62-Col. 59 line 6, Col. 141 line 34-Col. 142 line 40, Col. 58 line 62-Col. 59 line 6, Col. 175 line 61-Col. 176 line 21, Col. 228 lines 11-25, Col. 230 line 43-54, Col. 329 line 46-Col. 330 line 45.

As per claim 41 and 42, Ginter discloses executable code (applicant's report generation module) for indicating a provider's billing information in connection with providing services for the various media assets present on the data network. For various schemes, see at least , Col. 56 line 30-57, Col. 241 line 34-Col. 242 line 40, Col. 292 line 14-Col. 291 line 10, Col. 329 line 11--Col. 335 line 52.

As per claim 10, Ginter discloses

(a) tracking information uniquely identifying a media asset within the data network. See, for example, references to object ID, at least Figs. 15a, 26 and related text. See also at least Col. 119, line 45-Col. 120, line 43. See also at least references to billing and Object ID, Col. 192, lines 1-64.

(b) tracking information specifying characteristics of the asset. See, for example, at least Col. 22, line 26-Col. 23, line 33, which describes that billing may be done based on characteristics of particular media asset's size, or predefined nature such as images.

(c) tracking information identifying a particular user who uploaded the asset.

See, for example, at least references to billing and user ID numbers, Col. 108, line 63-Col. 109, line 18. See also at least Col. 119, line 45-Col. 120, line 43.

As per claims 11 and 33, Ginter discloses that various reports may provide billing information based on characteristics of a particular media asset. See, for example, at least Col. 22 line 26-Col. 23, line 33, which describes that billing may be done based on characteristics of particular media asset's size, or predefined nature such as images. See also at least, Col. 28 line 16-42, Col. 42 line 35-Col. 43 line 20, Col. 114 lines 4-57, Col. 154 line 41-Col. 155 line 2, Col. 166 line 20-Col. 167 line 10, Col. 188 line 39-Col. 189 line 40.

As per claims 12 and 34, Ginter discloses that various reports may provide billing information based on a particular media asset's size. See, for example, at least Col. 23, lines 1-32, which discloses that a user may be billed according to the size of selected media, measured in number of bytes.

As per claims 13 and 35, Ginter discloses that various reports may provide billing information based on a particular media asset's media type. See, for example, at least Col. 43 lines 43-57, Col. 314 lines 62-Col. 315 line 25.

As per claim 14, Ginter discloses that requests may be received from a user other than the user who uploaded the particular media asset to the data network. See, for example, at least references to end-users, teacher customers, and others, Col. 338, lines 29-49. See also at least Figs. 78-87 and related text for examples of users (other

than the user who uploaded a particular media asset to the data network) who request media assets.

As per claim 15, Ginter discloses

(a) receiving input indicating that the particular media asset may be shared with other particular users on the data network. See, for example, at least references to rights records, Fig. 22 and related text. See also at least references to user/group rights records, for example, Fig. 21 and related text.

(b) receiving a request from one of the other particular users to engage one or more of said service providers to perform one or more services for the particular media asset. See, for example, Col. 77, lines 15-41. See also at least references to end-user customers, Fig. 18 and related text, at least Col. 137, lines 21-50. For other examples of customers using particular media assets, please see at least Col. 278, line 40-Col. 279, line 32. See also at least references to users **11**, in Figs. 2 and 77 and related text. These rights distributors (applicant's service providers / partners) receive requests from customers to perform services for particular media assets. In that customers may request to download and use information.

(c) tracking transaction information allowing billing of the requested services.

See at least Col. 24, lines 24-48, for references to meters to record usage that is later billed. Ginter also discloses tracking transaction information allowing billing of other particular user(s) who requested the services. For example, see at least references to Secure Document Management, at least Col. 299, line 10-Col. 302, line 38.

As per claim 16 and 32, Ginter discloses uniquely identifying the particular media asset, so that it may be distinguished from all other media assets on the data network. Each uploaded content is provided with a unique identifier, See, for example, references to object ID, at least Figs. 15a, 26 and related text. See also at least Col. 119, line 45-Col. 120, line 43. See also at least references to billing and Object ID, Col. 192, lines 1-64.

As per claims 17 and 38, Ginter discloses uniquely identifying a particular device that the particular media asset was received from. For example, see references to device ID, appliance identification, at Col. 108, line 64-Col. 109, line 11, Col. 234, lines 21-44, Col. 259, line 23-Col. 260, line 31, Col. 344, line 60-Col. 345, line 30.

As per claims 18 and 39, Ginter discloses that transactions that are tracked may comprise e-commerce transactions carried out over the Internet. See, for example, at least references to commercial transactions on the Internet, Col. 18, line 39-Col. 19, line 27, Col. 24, line 49-Col. 25, line 35.

As per claims 19 and 40, Ginter discloses that particular media asset may be uploaded to a data network using wireless communication. See, for example, at least references to wireless, Col. 250, line 55-Col. 251, line 26. see also references to cellular devices, including PDA's, and other portable appliances, at least Col. 255, line 40-Col. 258, line 40.

As per claim 20, Ginter discloses that particular media asset may be uploaded to a data network using wireline communication. See, for example, at least references to transmitting services over telephone lines, at least Col. 1, line 51-Col. 2, line 15.

As per claims 21 and 43, Ginter discloses billing of the requested services and may include information about credits and/or debits posted to accounts of the service providers that were engaged. See, for example, at least Col. 292, line 14-Col. 293, line 10. For clearinghouse and billing, please see at least Col. 36, lines 10-43, Col. 43 lines 43-57, Col. 296 line 57-Col. 297 line 2, Col. 309 line 39-Col. 313 line 8, Col. 314 line 62-Col. 315 line 25, Col. 316 line 53-Col. 317 line 13.

As per claim 31, Ginter discloses a system that tracks information characterizing a type for a particular media asset of interest. See, for example, at least references to content type, Col. 8, line 50-Col. 9 line 2, Col. 26, line 66-Col. 28, line 17, Col. 95, lines 33-65, Col. 267, line 20-Col. 281, line 14, Col. 308, lines 36-62.

As per claim 36, Ginter discloses executable code for receiving input indicating that the particular media asset may be shared with other particular users on the data network. See, for example, at least references to creators inputting usage rights, Col. 294, line 1-Col. 295, line 26, Col. 339, line 28-Col. 342, line 64.

As per claim 37, Ginter discloses executable code that may produce reports that allow billing of services cess a request from a user that the particular media asset is being shared with. For example, see at least references to Secure Document Management, at least Col. 299, line 10-Col. 302, line 38. See also references to collecting audit information that reflects usage by different individuals for payment, at least Col. 32, line 35-Col. 33, line 20, Col. 45, line 63-Col. 46, line 15.

Claims 5 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., (US 5,892,900) in view of Chui et al (US 6,657,702).

As per claims 5 and 26, Ginter discloses that media assets may include digital images. See, for example, at least Col. 23, lines 1-36.

As per claims 5 and 26, Ginter **does not** specifically disclose that a service provider may provide **photo-finishing** services. Chui discloses that service providers may provide photo-finishing services. See, for example, at least Figs. 3B, 4, related text.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Ginter and Chui to disclose that a service provider may provide photo-finishing services. One of ordinary skill in the art at the time the invention was made would have been motivated to combine Ginter and Chui to disclose that a service provider may provide photo-finishing services for the obvious reason that a user may wish to share images with other persons, for example, a family member or a friend. By placing an image at a gateway like Ginter's and making the image available to family members and friends, a user may avoid entering a considerable amount of redundant information and incurring additional expenses.

Response to Arguments

Previously, Applicant argued that Ginter, does not disclose a gateway. Applicant now argues that while Ginter discloses a gateway, Ginter's gateway does not carry out functions of applicant's "**media gateway**", specifically

"....a media gateway associated with the data network, wherein the media gateway receives a plurality of media assets uploaded from a plurality of devices..."

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine

the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The accepted meaning is “a device that connects networks using different communications protocols so that information can be passed from one to the other.”³ Applicant’s uses the term “media gateway” to refer to specific functions of a gateway.

Nevertheless, Ginter discloses device(s) that receive plurality of media assets uploaded from a plurality of devices. See, for example at least Fig. 1, which discloses multiple networks connected to Ginter’s information utility network. These networks are often connected by gateway device(s) so that information can be passed from one to the other (uploaded and downloaded). Such information includes a plurality of media assets. Several examples include a video production studio (204) connected to 200. See also office 210, which shows a plurality of devices (one per window) connected to a network that connects to 200. Each entity in Fig. 1 may connect to 200 via gateway(s).

Again, Applicant is respectfully requested to note that Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially

³ Definition of gateway, MICROSOFT PRESS Computer Dictionary.

teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant's arguments concerning claims 5 and 26 appear to be based solely on rejection of claims 1 and 22. These arguments are not persuasive for reasons above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Zurita
Patent Examiner
Art Unit 3625
11 February 2005


MARVIN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600